

### REMARKS

Claims 94, 96-121, 124, 127-170 are pending in the above-referenced patent application. Applicants respectfully request further consideration of the claims, in view of the amendments set forth above and the following remarks.

#### Amendments to the Claims

Claims 98, 99, 130 and 133 have each been amended to correct certain antecedent basis concerns, without change in the substantive scope thereof. No new matter is added.

#### Acknowledgements

Applicants acknowledge that various rejections and objections set forth previously by the Office have been withdrawn. *See* paragraphs 2, 3 and 4 of the Office action.

#### Rejections Under 35 U.S.C. § 112

The Office action rejects each of claims 98, 99, 130 and 133 as being indefinite under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph with respect to various antecedent basis concerns.

Applicants have amended these claims to obviate this basis for rejection.

#### Double Patenting Rejections

The Office has rejected the pending claims under the judicially-created doctrine of obvious-type double patenting with respect to U.S. Patent No. 6,004,617, U.S. Patent No. 6,346,290, U.S. Patent No. 6,794,052 and U.S. Ser. No. 09/881,036 (recently granted as U.S. Patent No. 6,864,201).

Applicants are submitting herewith a Terminal Disclaimer to obviate this basis for rejection.

#### Statement regarding Commonly Owned Patents

The Office has noted a potential basis for rejection under 35 U.S.C. § 103 / 102(e), (f) and/or (g) in view of U.S. Patent No. 6,004,617, U.S. Patent No. 6,346,290, U.S. Patent No. 6,794,052 and U.S. Ser. No. 09/881,036 (recently granted as U.S. Patent No. 6,864,201). *See* paragraphs 8, 10, 12 and 14 at pages 4 through 10 of the Office action.

As demonstrated by the following statements and the copies of the assignment documents attached hereto, the present invention and the inventions defined in each of the aforementioned patents and applications noted in the Office action were commonly owned at the time of the present invention. Accordingly, under 35 U.S.C. §103(c), such patents and applications would not be prior art to the instant invention.

Specifically, at the time of the invention defined by the claims of the instant patent application: (i) the subject matter of the instant patent application was co-owned by or subject to an obligation of assignment to Symyx Technologies, Inc. and the Regents of the University of California.; and (ii) the subject matter of each of the referenced patents and applications (U.S. Patent No. 6,004,617, U.S. Patent No. 6,346,290, U.S. Patent No. 6,794,052 and U.S. Ser. No. 09/881,036 (now U.S. Patent No. 6,864,201)) were co-owned by or subject to an obligation of assignment to Symyx Technologies, Inc. and the Regents of the University of California.

Attached hereto are copies of the assignments of both the instant application (Ser. No. 10/074,745) and the referenced patents and applications (U.S. Patent No. 6,004,617, U.S. Patent No. 6,346,290, U.S. Patent No. 6,794,052 and U.S. Ser. No. 09/881,036 (now U.S. Patent No. 6,864,201)) demonstrating co-ownership thereof as being vested with Symyx Technologies, Inc. and the Regents of the University of California, as follows:

(a) Ser. No. 10/074,745, the instant application, is a continuation application of Ser. No. 09/127,195 (issued as U.S. Patent No. 6,346,290), which was a divisional application of Ser. No. 08/327,513 (issued as U.S. Patent No. 5,985,356). A copy of the assignments for U.S. Patent No. 5,985,356 is attached hereto.

(b) U.S. Patent No. 6,004,617 issued from Ser. No. 08/480,007, which was a divisional application of Ser. No. 08/438,043 (issued as U.S. Patent No. 5,776,359), which itself was a continuation-in-part application of Ser. No. 08/327,513 (issued as U.S. Patent No. 5,985,356). A copy of the assignments for U.S. Patent No. 5,985,356 is attached hereto.

(c) U.S. Patent No. 6,346,290 issued from Ser. No. 09/127,195 (issued as U.S. Patent No. 6,346,290), which was a divisional application of Ser. No. 08/327,513 (issued as U.S. Patent No. 5,985,356). A copy of the assignments for U.S. Patent No. 5,985,356 is attached hereto.

(d) U.S. Patent No. 6,794,052 issued from Ser. No. 10/226,485, which was a continuation application of Ser. No. 09/794,228 (abandoned), which itself was a divisional application of Ser. No. 08/482,921 (issued as U.S. Patent No. 6,326,090), which itself was a divisional application of Ser. No. 08/438,043 (issued as U.S. Patent No. 5,776,359), which itself was a continuation-in-part application of Ser. No. 08/327,513 (issued as U.S. Patent No. 5,985,356). A copy of the assignments for U.S. Patent No. 5,985,356 is attached hereto.

(e) U.S. Ser. No. 09/881,036 (now U.S. Patent No. 6,864,201) is a divisional application of Ser. No. 09/127,195 (issued as U.S. Patent No. 6,346,290), which was a divisional application of Ser. No. 08/327,513 (issued as U.S. Patent No. 5,985,356). A copy of the assignments for U.S. Patent No. 5,985,356 is attached hereto.

In view of the foregoing facts, Applicants respectfully submit that there is no basis for rejecting the presently pending claims under 35 U.S.C. § 103 / 102(e), (f) and/or (g) in view of any of U.S. Patent No. 6,004,617, U.S. Patent No. 6,346,290, U.S. Patent No. 6,794,052 and U.S. Ser. No. 09/881,036 (recently granted as U.S. Patent No. 6,864,201)

#### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants believe that no further fees are required in connection with this Amendment G. If necessary however, the Examiner is also authorized to debit any necessary fees for this amendment, or any other fees required in connection with this

Application Serial No. 10/074,745

Docket No. 220032001301(94-1DIV2CON2RCE)

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application, or to credit any overpayment of fees in connection with this application to

Deposit Account No. 50-0496.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul A. Stone". The signature is fluid and cursive, with the first name "Paul" being more prominent.

Date Submitted: May 23, 2005

Paul A. Stone  
Reg. No. 38,628

c/o Symyx Technologies, Inc.  
3100 Central Expressway  
Santa Clara, CA 95051  
Phone: (408) 773-4024  
Fax: (408) 773-4029